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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/491,949	01/26/2000	Salim G Kara	45923-P004CP1C1-09908772	9277

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DALLAS OFFICE OF FULBRIGHT & JAWORSKI L.L.P.
2200 ROSS AVENUE
SUITE 2800
DALLAS, TX 75201-2784

EXAMINER

COSIMANO, EDWARD R

ART UNIT PAPER NUMBER

3629

DATE MAILED: 01/13/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/491,949

Applicant(s)

KARA, SALIM G

Examiner

Edward R. Cosimano

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 November 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-36 is/are pending in the application.
- 4a) Of the above claim(s) none is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-19 is/are allowed.
- 6) ☒ Claim(s) 20-36 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 26 January 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 6.5.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

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1. Applicant should note the changes to patent practice and procedure:
 - A) effective December 01, 1997 as published in the Federal Register, Vol 62, No. 197, Friday October 10, 1997; and
 - B) effective November 07, 2000 as published in the Federal Register, Vol 65, No. 54603, September 08, 2000.
2. The disclosure is objected to because of the following informalities:
 - A) applicant must update:
 - (1) the continuing data on page 1, and
 - (2) the application data on page(s) 9, 15, 20-21 & 30,with the current status of each of the referenced applications, e.g., --now abandoned--, or --now patent #?--, or --which is abandoned and now serial number #?--, etc.

Appropriate correction is required

3. The specification and drawings have not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification or drawings. Applicant should note the requirements of 37 CFR § 1.74, § 1.75, § 1.84(o,p(5)), § 1.121(a)-1.121(f) & § 1.121(h)-1.121(i).
4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. § 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

(102(e) only) The changes made to 35 U.S.C. § 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under

35 U.S.C. § 122(b). Therefore, this application is examined under 35 U.S.C. § 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. § 102(e)).

4.1 Claims 20-29 are rejected under 35 U.S.C. § 102(e) as being clearly anticipated by Brasington et al (5,923,406).

4.1.1 In regard to claims 20, 25-27, as can be seen in fig. 8 of Brasington et al ('406) a number of postage stamps that have been printed on a sheet of material at the demand of an user and where the sheet of material permits each of the postage stamps to be separated and then applied to an item of mail. Where as each stamp is printed the value of the stamp is deducted from a postage credit value, (note column 6, lines 11-51).

4.1.2 In regard to claim 22, it is noted that since each stamp is separable from the rest of the stamps printed on the sheet of material, the each stamp is printed on it's own transfer medium.

4.1.3 In regard to claim 23, it is noted that since each stamp must be applied to an item of mail, the stamp of Brasington et al ('406) must have some type of adhesive applied to the label/transfer section.

4.1.4 In regard to claims 23, 24, 28 & 29, note the feature of the invention designated by reference number 77.

5. The following is a quotation of 35 U.S.C. § 103 which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

(c) Subject matter developed by another person, which qualifies as prior art only under subsection (f) or (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

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5.1 Claims 30-36 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Brasington et al (5,923,406) as applied to claims 20-29 and further in view of Kara (WO 97/14117).

5.1.1 In regard to claims 30-33, Brasington et al ('406) does not disclose the use of an unique two dimensional barcode as a security imprint for each stamp, however, in the environment of postage metering Kara (WO 97/14117) does disclose that it is known to use an unique two dimensional barcode as a security imprint for each stamp/indicia so as to provide evidence of the payment of the appropriate postage.

5.1.2 Since the stamps of Brasington et al ('406) represent the payment of postage value, it would have been obvious to one of ordinary skill at the time the invention was made that the system of Brasington et al ('406) could be modified to include an unique two dimensional barcode as a security imprint for each stamp/indicia so as to provide evidence of the payment of the appropriate postage as taught by Kara (WO 97/14117).

5.1.3 In regard to claims 34-36, note the use of at least one stamp per item of mail in Brasington et al ('406).

6. The following is an Examiner's Statement of Reasons for Allowance over the prior art:

A) The prior art of interest, for example:

(1) either Mercur (3,221,980) or Daumann (DE 4409386) or Schwartz et al (Wo 97/40472) or Fabel (2002/0149196), which disclose the use of a windowed envelope so that a postage indicia on the item of mail may be seen.

(2) either Terrell or the Computergram International article, which disclose printing a postage indicia on either an envelope or a mailing label which is to be affixed to an item of mail.

(3) Pike et al (5,902,439), which discloses producing multiple postage stamps on a medium for a fee and further discloses that the stamps may be removed and affixed to items of mail.

(4) either Brasington (5,923,406) or Kikuchi (JP 11-249205), which disclose producing multiple personalized postage stamps on a medium for a fee

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and further discloses that the personalized stamps may be removed and affixed to items of mail.

B) however, the prior art does not teach or suggest a general purpose processor and printer being used to print multiple postage indicia on a sheet containing multiple transfer sections. Claims 2-19 are allowable for the same reason.

7. Response to applicant's arguments.

7.1 All rejections and objections of the previous Office action not repeated or modified and repeated here in have been over come by applicant's last response.

7.2 Since applicant failed to update the application information, this objection has been maintained, note the attached appendix.

8. The shorten statutory period of response is set to expire 3 (three) months from the mailing date of this Office action.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Edward Cosimano whose telephone number is (703) 305-9783. The examiner can normally be reached Monday through Thursday from 7:30am to 6:00pm. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss, can be reached on (703)-308-2702. Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-1113.

9.1 The fax phone number for UNOFFICIAL/DRAFT FAXES is (703) 746-7240.

9.2 The fax phone number for OFFICIAL FAXES is (703) 305-7687.

9.3 The fax phone number for AFTER FINAL FAXES is (703) 308-3691.

01/08/03



Edward R. Cosimano

Primary Examiner A.U. 3629

APPENDIX

In the specification:

Change the first paragraph on page 1, to:

-- This application is a continuation of co-pending, commonly assigned, patent application entitled "SYSTEM AND METHOD FOR PRINTING MULTIPLE POSTAGE INDICIA", serial number 08/965,015 now U. S. Patent number 6,208,980, which itself is a continuation-in-part of co-pending, commonly assigned, patent application, entitled "SYSTEM AND METHOD FOR PRINTING POSTAGE INDICIA DIRECTLY ON DOCUMENTS," serial number 08/561,417 filed November 21, 1995 now U. S. Patent number 5,801,944, which itself is a continuation-in-part of co-pending, commonly assigned patent application, entitled "SYSTEM AND METHOD FOR PRINTING PERSONALIZED POSTAGE INDICIA ON GREETING CARDS", serial number 08/540,658 filed October 11, 1995 now U. S. Patent number 5,717,597, which applications are hereby incorporated by reference herein. Reference is hereby made to concurrently filed, co-pending and commonly assigned U.S. Patent application entitled "SYSTEM AND METHOD FOR PROVIDING FAULT TOLERANT TRANSACTIONS OVER AN UNSECURED COMMUNICATION CHANNEL," serial number 08/965,069 now U. S. Patent number 6,199,055, the disclosure of which application is incorporated herein by reference.--

Change the paragraph at page 9, lines 5-10, to:

-- The present invention further provides for a method and system, described in co-pending U.S. application serial no. 08/263,751 now U. S. Patent number 5,606,507 and incorporated herein by reference, for automatically calculating the appropriate amount of postage for a piece of mail, printing that amount of postage and deducting the printed amount of postage from the total amount of postage stored within the portable postage storage device. In addition, the present invention allows the user to retrieve, select, personalize and print postage indicia.--

Change the paragraph at page 15, lines 19-24, to:

-- A preferred embodiment of the above described TMU button is disclosed in the co-pending commonly assigned, U. S. application serial number 08/965,069 now U. S. Patent number 6,199,055 entitled "SYSTEM AND METHOD FOR PROVIDING FAULT TOLERANT TRANSACTIONS OVER AN UNSECURED COMMUNICATION CHANNEL,"

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previously incorporated herein by reference. This preferred embodiment includes a TMU button having a processor operating under control of a limited purpose operating code providing secure data storage and interaction.--

Change the paragraph between page 20, line 16, and page 21, line 3, to:

-- Alternatively, a pair of systems 10 may be linked together through public switched network ("PSN") 102, or other communication gateway such as the Internet or other computer network, via modem 101 or directly through digital telecommunications trunks or other communications links (not shown). Processor based systems 10 located at different U.S. Post Offices may be linked via PSN 102 in a conventional well known manner (such as through modem 101) so that information may be shared between the various Post Offices. Generally, a copy of the POSTAGEMAKER program will be stored within at least one processor-based system at selected U.S. Post Office locations. PSN linkage of processor-based systems 10 by the Post Office and the user will allow the sharing of information between the various Post Offices and will allow a user to call a number (an authorized Post Office number) and have the Post Office transfer the required amount of postage to a postage storage device 18 installed at a user site by modem. A preferred embodiment of a system and method for conducting transactions, such as that described above, is disclosed in co-pending commonly assigned U.S. application serial number 08/965,069 now U. S. Patent number 6,199,055 entitled "SYSTEM AND METHOD FOR PROVIDING FAULT TOLERANT TRANSACTIONS OVER AN UNSECURED COMMUNICATION CHANNEL," previously incorporated herein by reference.--

Change the paragraph at page 30, lines 16-20, to:

-- A preferred method for conducting the above described transactions with the button is described in co-pending commonly assigned U.S. application serial number 08/965,069 now U. S. Patent number 6,199,055 entitled "SYSTEM AND METHOD FOR PROVIDING FAULT TOLERANT TRANSACTIONS OVER AN UNSECURED COMMUNICATION CHANNEL," previously incorporated herein by reference.--